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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,063	02/09/2005	Boris Mayer	30882/DP019	4442
4743 7590 07/07/2009 MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606-6357			EXAMINER GLASS, RUSSELL S	
			ART UNIT 3687	PAPER NUMBER
			MAIL DATE 07/07/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,063

Applicant(s)

MAYER ET AL.

Examiner

R. SHAY GLASS

Art Unit

3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination

Applicant's arguments provided in the Appeal Brief filed 3/11/2009 regarding claim 22 are persuasive, and as such the finality of the office action dated 8/15/2008 is hereby withdrawn and prosecution is reopened in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tilles et al. (6,748,295) in view of Gustafsson (6,424,841).

1. As per claims 18 and 22, Tilles et al. discloses a method and device for transmitting notifications (information) to users of a logistic system, said logistic system comprising at least one parcel compartment system with at least one registered user, wherein notification orders are transmitted to a central sending component which, on the basis of the notification orders (parcel status), accesses at least one database and generates and sends appropriate notifications to the user (email or the like informing user of parcel status), the method comprising the steps of:

(a) calling up different modules (See the Abstract, via ActiveX software components) with associated functions in response to different events within the logistic system (See parcel status events or user events), said modules being selected from the group consisting of a client database

(See col. 13 at lines 33-39, via a master server database), a registration unit (See col. 13 at lines 33-39, via user registration), and a system administration unit for the logistic system (See col. 6 at lines 25-28, via supervisor and manager system access);

(b) generating notification ("the transmission of information", see paragraph 3 of the written description) orders by the modules (See col. 12 at lines 49-54, via internet email notifications);

(c) writing the notification orders into a communication request queue (a software instruction queue, (see the Abstract, col. 13, line 33-col 14, line 21, via application software; or a database used for queuing email notifications); and

reading the orders from the communication request queue (program instruction queue) by a queue reader (memory device) in a timer-controlled manner (a scanner which includes a timer based central processing unit CPU or microprocessor) and transferring the orders to the central sending component, (See col. 13 at lines 5-7 and 33-65, disclosing that an e-mail notification is sent to customers e-mail address when an item is stored in the IDRS);

(d) generating appropriate user-specific notifications by the central sending component (See col. 13 at lines 33-35, via user-specific email notifications); and,

(e) sending said notifications to the user by the central sending unit via a gateway (master server 20 or web server 32, see col. 3 at lines 64-67); wherein said generating step includes accessing at least one client database (See col. 13 at lines 33- 36, via a master server database), a parcel database (See Figure 10 and col. 10 at lines 41-44, via local item inventory database), an automatic parcel delivery machine database (See Figure 11, via a carousel database 128), and a document database (See col. 10 at line 23, via database maintenance reports) by the central sending component (master server 20 or web server 32, See col. 3 at lines 64-67), wherein said

method further includes the step of validating the status of the notification orders in a delivery contract logic before transferring the notification orders to the central sending component (See col. 13 at lines 31-54, via a user selecting delivery contract logic allowing mail to be delivered directly to a compartment system, the system checks (validates) to see if the contract option has been selected and notifies the user when compartment mail is available).

However, Tilles et al. fails to explicitly disclose writing the notification orders into a communication request queue so the orders can be sent in a deferred manner. Gustafsson discloses a short message service with improved utilization of available bandwidth including writing the notification orders into a communication request queue so the orders can be sent in a deferred manner (See col. 3 at lines 11-27, via a deferred SMS messaging service).

From this disclosure of Gustafsson it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify the item delivery and retrieval system of Tilles et al. to include writing notification orders into a communication request queue so the order can be sent in a deferred manner as taught by Gustafsson in order to efficiently utilize SMS systems to accommodate subscribers.

2. As per claim 19, Tilles et al. discloses the step of allocating client data, parcel data, and parcel compartment system data in the databases by means of IDs (See the Abstract, via customer identification so as to permit retrieval of items located in specifically designated bins; customer IDs being accessible by master server 20).
3. As per claim 20, Tilles et al. discloses wherein the events in the logistic system comprise at least the following:
 - registration of the new user (See col. 13 at lines 33-39, via user registration)

- change in the user data (See col. 13 at lines 29-31, via taking a picture of the user when picking up an item)
- placement of a new parcel in a parcel compartment system (See col. 12 at lines 63-65, via loading of the storage unit)
- picking up a parcel from a parcel compartment system (See col. 13 at lines 8-9, via a user retrieving an item)
- sending back a parcel (See col. 10 at lines 66-67, via the return item function)
- adding a substitute for pick-up of a parcel (See col. 14 at lines 43-45, via a customer loyalty card transferable to a substitute for pick-up of a parcel).
- removing a substitute (See col. 14 at lines 43-45, via taking away a customer loyalty card from a substitute).

4. As per claim 21, Tilles et al. discloses all elements of the claimed invention but fails to explicitly disclose the step of sending the notifications to the users in the form of at least one of e-mail and SMS. Gustafsson discloses a short message service with improved utilization of available bandwidth including the step of sending the notifications to the users in the form of at least one of e-mail and SMS (See col. 1 at lines 60-67, via an SMS e-mail notification message).

From this disclosure of Gustafsson it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify the item delivery and retrieval system of Tilles et al. to include sending an SMS email message as taught by Gustafsson, in order to efficiently utilize SMS systems to accommodate subscribers.

Response to Arguments

1. In response to applicant's argument that the combination of Tilles and Gustafsson fails to disclose "writing the notification orders into a communication request queue so the orders can be sent in a deferred manner", it is submitted that the claims fail to actively recite sending orders in a deferred manner, and instead only recite sending orders in a timer-controlled manner. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.
2. As per Applicant's argument that Tilles fails to disclose "reading the orders from the communication request queue by a queue reader in a timer-controlled manner, it is submitted that Tilles in fact teaches such a limitation, (See col. 13 at lines 5-7 and 33-65, disclosing that an e-mail notification is sent to customers e-mail address when an item is stored in the IDRS and will not be delivered). Furthermore, the active X controls that run the carousel are disclosed as being temporary or time-dependant on the processing time of the applications that host them, (see Tilles, col. 8, lines 55-58).
3. In response to applicant's argument that one of ordinary skill in the art would not be motivated to combine Tilles and Gustafsson because Tilles is directed toward broadband communication and Gustafsson is directed toward narrowband communication and therefore the addition of Gustafsson to Tilles would be unnecessary, it is submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly

suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. SHAY GLASS whose telephone number is (571)272-7285. The examiner can normally be reached on weekdays between 9 AM and 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW GART can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/R. SHAY GLASS/
Examiner, Art Unit 3687

/Vanel Frenel/

Examiner, Art Unit 3687

July 6, 2009